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BRIAN R. WOODWORTH  
275 N. FIELD DRIVE  
DEPT. NLEG BLDG H-1  
LAKE FOREST IL 60045-2579

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**OFFICE OF PETITIONS**

In re Application of  
Holland, et al.  
Application No. 10/783,641  
Filed: 20 February, 2004  
Attorney Docket No. 7135US01

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DECISION ON PETITION

This is a decision on the petition filed on 14 April, 2005, to withdraw the holding of abandonment and considered under 37 C.F.R. §1.181.

The petition is **DISMISSED**.

**BACKGROUND**

A review of the application file reveals that:

- Petitioner failed to reply timely and properly to the Notice of Missing Parts (oath/declaration) mailed on 14 May, 2004, with reply due under a non-extendable deadline on or before 14 July, 2004;
- the application went abandoned after midnight 14 July, 2004;
- the Office mailed a Notice of Abandonment on 9 February, 2005;
- on 14 April, 2005, Petitioner Michael Crabb (Reg. No. 37,298) filed the instant petition, and averred that his review of his files and docket records indicated that the Notice of the 14 May, 2004, had not been received;

- it is noted that the record in the form of the oath/declaration, submitted by Petitioner, directed that correspondence was to be mailed to:

Steven Weinstock  
Abbott Laboratories  
D-377/AP6A  
100 Abbott Park Road, Abbott Park, IL 60064-6050

while the application transmittal, signed by Petitioner, directed that correspondence be mailed to the address corresponding to Customer No. 23, 492, which is:

Steven Weinstock (later: Robert Debaradine)  
Abbott Laboratories  
D-377/AP6A  
100 Abbott Park Road, Abbott Park, IL 60064-6008

- it further is noted that Petitioner failed to file the instant petition within two (2) months of the date (9 February, 2005) of the act complained of (Notice of Abandonment);<sup>1</sup>
- nonetheless, for reasons that are unclear in the record, on 27 January, 2006, the Office appears to have withdrawn the holding of abandonment in this matter;
- while the withdrawal of the 9 February, 2005, holding of abandonment therefore appears inconsistent with Office policy because:

–the required showing cannot be made due to Petitioner's conflicting and inconsistent correspondence instructions to the Office (an inconsistency which Petitioner has not addressed in the instant petition); and

–Petitioner's instant filing was not timely under the applicable rule, and,

thus, the withdrawal appears to have been in error, the action has been taken and the undersigned is not empowered to re-instate the Notice of Abandonment.

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<sup>1</sup> See: 37 C.F.R. §1.181.

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>3</sup>

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup> And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>)

The courts have outlined the construct for the granting of relief as to the withdrawal of the holding of abandonment. (See: *Delgar v. Schulyer*.<sup>8</sup>)

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<sup>2</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>5</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>8</sup> *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

CONCLUSION

While the record appears to leave in question whether Petitioner satisfied the *Delgar* requirements to support the withdrawal of the holding of abandonment, it appears that the Office has so acted and no further action is required.

Accordingly, the instant petition under 37 C.F.R. §1.181 must be and hereby is **dismissed as moot**.

The instant application is released to OIPE for further processing as necessary before being released for substantive examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions